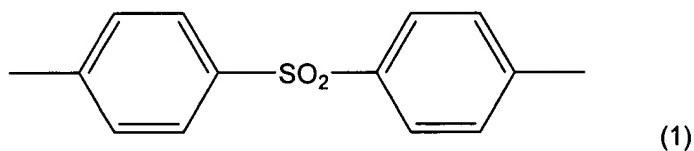


### C. Remarks

The claims are 1-3, 10-13, 30 and 35, with claim 1 being the sole independent claim. Reconsideration of the present claims is expressly requested.

Claims 1-3, 10-13 and 30 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,525,446 (Sypula). The grounds of rejection are respectfully traversed.

The Examiner has alleged in the Advisory Action that Sypula teaches the conventionality of single layer intermediate transfer belts in column 1, lines 57-63. Applicants note that they do not claim to have invented the first single-layer belt. One of the key features of the present invention is that a single-layer belt has a conductive agent and a thermoplastic resin represented by Formula (1):



Applicants respectfully submit that even though Sypula discloses some single layer belts in column 1, lines 57-63, this disclosure cannot be used to modify the belt in Sypula to render the presently claimed invention unpatentable.<sup>1</sup>

In its background section, Sypula discloses that there are known single layer belts. However, according to Sypula, such belts do not have desirable mechanical strength and electrical properties for transferring a full color image with high color fidelity. To

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<sup>1/</sup> Applicants note that none of prior art belts disclosed in the background section of Sypula have a resin with a diphenyl sulfone structure as presently claimed.

solve this problem, Sypula discloses a belt comprising a film base layer and a top thermoplastic film forming polymer layer, which are bonded together by an adhesive, i.e., a multi-layer structure.

Sypula states that “[t]he top layer has the proper electrical properties for charge dissipation which is necessary for toner image transfer.” (Col. 2, lines 43-44). Thus, removing the top layer would deprive the belt of a function Sypula considers necessary.

In fact, as mentioned above, Sypula’s goal is to overcome insufficient electrical properties of the prior art belts. Therefore, Sypula teaches away from the modification proposed by the Examiner, because such a modification would create the very problem Sypula attempts to solve. Sypula does not disclose or suggest that the proper electrical properties of the top layer are compensated for by the base layer. Consequently, if the top layer is removed and the remaining base layer in Sypula is not taught as being capable of functioning as a toner transfer member in an electrophotographic apparatus, Sypula cannot render the presently claimed invention unpatentable.

As stated in M.P.E.P. 2111.04(II)(B), “omission of an element and retention of its function is an indicia of non-obviousness” (emphasis added). Thus, even if the base layer in Sypula could function as a transfer member without the top layer, a previously undisclosed retention of its necessary functionality prevents Sypula from rendering the presently claimed invention obvious. See In re Edge, 149 U.S.P.Q. (BNA) 556 (C.C.P.A. 1966).

The Examiner’s reliance on Applicants’ disclosure regarding the fact that the belt can have one or more layers is impermissible hindsight reasoning, which cannot be

used to show a suggestion or motivation to modify Sypula. Examiner's reliance on prior art single-layer belts mentioned in Sypula cannot serve as motivation or suggestion for modifying Sypula, because Sypula effectively teaches away from single-layer structures of these prior art documents. Accordingly, it is clear that Sypula cannot affect the patentability of the presently claimed invention.

Wherefore, Applicants respectfully submit that the presently claimed invention is patentable over Sypula and request that the outstanding rejection be withdrawn and the present case be passed to issue.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

  
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